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TRANSMITTAL FORM

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Total Number of Pages in This Submission

Application Number	10/648,124
Filing Date	August 25, 2003
First Named Inventor	Aurelian Vasile Lazarut
Art Unit	2825
Examiner Name	Naum B. Levin
Attorney Docket Number	X-1391 US

ENCLOSURES (Check all that apply)

<input type="checkbox"/> Fee Transmittal Form <input type="checkbox"/> Fee Attached <input checked="" type="checkbox"/> Amendment/Reply <input type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s) <input type="checkbox"/> Extension of Time Request <input type="checkbox"/> Express Abandonment Request <input type="checkbox"/> Information Disclosure Statement <input type="checkbox"/> Certified Copy of Priority Document(s) <input type="checkbox"/> Reply to Missing Parts/ Incomplete Application <input type="checkbox"/> Reply to Missing Parts under 37 CFR 1.52 or 1.53	<input type="checkbox"/> Drawing(s) <input type="checkbox"/> Licensing-related Papers <input type="checkbox"/> Petition <input type="checkbox"/> Petition to Convert to a Provisional Application <input type="checkbox"/> Power of Attorney, Revocation Change of Correspondence Address <input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Request for Refund <input type="checkbox"/> CD, Number of CD(s) _____ <input type="checkbox"/> Landscape Table on CD	<input type="checkbox"/> After Allowance Communication to TC <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input type="checkbox"/> Appeal Communication to TC (Appeal Notice, Brief, Reply Brief) <input type="checkbox"/> Proprietary Information <input type="checkbox"/> Status Letter <input checked="" type="checkbox"/> Other Enclosure(s) (please identify below): Return Receipt Postcard
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Remarks

Response to Restriction Requirement after Filing an RCE

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm Name	XILINX, INC. CUSTOMER NO: 24309		
Signature			
Printed name	Justin Liu		
Date	October 27, 2006	Reg. No.	51,959

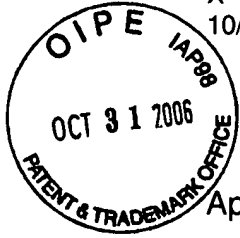
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Typed or printed name	Pat Tompkins	Date	October 27, 2006

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X-1391 US
10/648,124

PATENT
Conf. No. 3211

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: Aurelian Vasile Lazarut et al.

Assignee: Xilinx, Inc.

Title: Client-Server Semiconductor Verification System

Serial No.: 10/648,124

File Date: 08/25/2003

Examiner: Naum B. Levin

Art Unit: 2825

Docket No.: X-1391 US

Conf. No.: 3211

Mail Stop AMENDMENT
COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, VA 22313-1450

RESPONSE TO RESTRICTION REQUIREMENT

Dear Sir:

This Response and Election is filed herewith in response to the Office Communication dated September 28, 2006, having a reply period set to expire on October 28, 2006.

Claims 1-8, 10-13, and 15-30 are pending in the application. It was stated in the previous Office Action that restriction is required between two groups. The Office Action identifies Group 1 as corresponding to Claims 1-8, 10, and 16-25, and Group 2 as corresponding to Claims 11-13, 15, and 26-30.

Applicants respectfully traverse the restriction requirement, submitting that the restriction requirement is improper, and request the Examiner withdraw the restriction.

However, in order to comply with the requirements of 37 C.F.R. § 1.143, Applicants provisionally elect with traverse Group 1, Claims 1-8, 10, and 16-25, and withdraw Claims 11-13, 15, and 26-30 corresponding to Group 2 from consideration. Applicants reserve the right to request rejoinder under MPEP § 821.04 or otherwise reinstate the withdrawn claims, if appropriate,

and/or to prosecute any future cancelled claims in one or more subsequent divisional applications, without prejudice.

Applicants respectfully submit that this election should not be interpreted or construed as a limitation on the breadth and scope of elected and non-elected claims, but is merely a sufficient response to the restriction requirement.

In traversing the requirement, Applicants understand that pursuant to 37 C.F.R. § 1.142(a) and MPEP § 811 that a restriction may be made "at any time before a final action." However, MPEP § 811 goes on to state:

This means the examiner should make a proper requirement as early as possible in the prosecution, in the first action if possible, otherwise, as soon as the need for a proper requirement develops.

(Emphasis added.) In the present application, The Patent Office has sent a first office action, a final office action, and a first office action after the filing of an RCE (Request for Continued Examination), and after appropriate responses by Applicants to those office actions. Thus, since the Examiner has already presented no less than three separate actions on the merits, it appears that the requirement was not made as early as possible.

Furthermore, the reasons set forth in the present Office Action for the restriction requirement appear to be based on language that was included in the claims as originally filed. That is, the alleged distinctions cited by the Examiner between the two alleged groups were not added or amended materially during prosecution. Additionally, no new claims were added by any previous amendment.

Therefore, Applicants fail to see how the need for a requirement developed at this very late stage in prosecution. In short, the Examiner has clearly failed in his duty to make a requirement as early as possible in the prosecution, thereby prejudicing the rights of Applicants. Applicants respectfully request withdrawal of the present requirement.

MPEP § 811 further states:

Before making a restriction requirement after the first action on the merits, the examiner will consider whether there will be a serious burden if restriction is not required.

In the instant application, the Examiner has not made any showing as to, and thus does not appear to have considered, whether such a serious burden will exist. To the contrary, the Examiner's own actions and admissions lead only to the conclusion that no serious burden exists.

First, Applicants point out that the entire application, including all of the claims, have been previously examined by the Examiner, in no less than three separate office actions on the merits. In none of those three office actions did the Examiner give any indication that there was a serious burden if restriction is not required. In fact, the Examiner was apparently able to conduct a proper search for and examine all of the claims. Applicants fail to see how a serious burden has suddenly developed after three office actions on the merits.

Moreover, MPEP § 808.02 sets forth specific requirement that must be met in order to establish a serious burden:

Where the related inventions as claimed are shown to be independent or distinct . . . the examiner, in order to establish reasons for insisting upon restriction, must explain why there would be a serious burden on the examiner if restriction is not required. Thus the examiner must show by appropriate explanation one of the following:

(A) **Separate classification thereof:** This shows that each invention has attained recognition in the art as a separate subject for inventive effort, and also a separate field of search. Patents need not be cited to show separate classification.

(B) **A separate status in the art when they are classifiable together:** Even though they are classified together, each invention can be shown to have formed a separate subject for inventive effort when the examiner can show a recognition of separate inventive effort by inventors. Separate status in the art may be shown by citing patents which are evidence of such separate status, and also of a separate field of search.

(C) **A different field of search:** Where it is necessary to search for one of the inventions in a manner that is not likely to result in finding art pertinent to the other invention(s) (e.g., searching different classes/subclasses or electronic resources, or employing different search queries), a different field of search is shown, even though the two are classified together. The indicated different field of search must in fact be pertinent to the type of subject matter covered by the claims. Patents need not be cited to show different fields of search.

Where, however, the classification is the same and the field of search is the same and there is no clear indication of separate future classification and field of search, no reasons exist for dividing among independent or related inventions.

(Underline added.) Applicants respectfully submit that the Examiner has not just failed to make any such showing, but has, in fact, actually provided strong evidence to the contrary.

In particular, in the present Office Action, the Examiner specified that Groups 1 and 2 are both classified in class 716, subclass 4. That is, by the Examiner's own admission, the two alleged groups have the same classification. Thus, the Examiner freely admits that classification is the same, and has not alleged reasons or evidence of separate status of the art or a different field of search. Therefore, no reasons apparently exist for dividing the inventions, especially at this late point in prosecution.

All of this is further supported by MPEP § 803, which states:

If the search and examination of all the claims in an application can be made without serious burden, the examiner must examine them on the merits, even though they include claims to independent or distinct inventions.

Thus, even assuming the Examiner is correct in alleging that there is more than one invention, the Examiner is required to examine all of the claims if search and examination can be made without serious burden. Again, all of the claims have been previously examined by the Examiner without serious burden, so it appears that the MPEP dictates that the Examiner must continue to examine all

of the claims in the instant application, since it can apparently be done without serious burden.

Therefore, Applicants respectfully request withdrawal of the requirement in light of the lack of any showing of a serious burden.

Conclusion

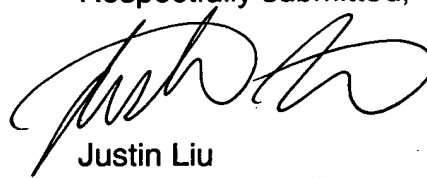
For the reasons set forth above, Applicants believe the restriction requirement is improper, and should be withdrawn. Therefore, Applicants respectfully request the restriction be withdrawn and all claims allowed. In the alternative, if the requirement is not withdrawn, Applicants respectfully request the Examiner make the requirement final so that Applicants may file a petition with the Director to review the requirement.

The Commissioner is hereby authorized to charge any fees which may be required or credit any overpayment to deposit account 24-0040.

Should the Examiner have any further comments and suggestions, it respectfully requested that the Examiner telephone the undersigned in order to expeditiously resolve any outstanding issues.

A listing of the claims in the present application is appended hereto, with current status.

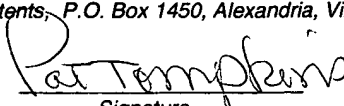
Respectfully submitted,



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Pat Tompkins
Name


Signature